

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF OKLAHOMA**

UNITHERM FOOD SYSTEMS, INC., an
Illinois corporation; and JENNIE-O-FOODS,
INC., a Minnesota corporation,

Plaintiffs,

v.

SWIFT-ECKRICH, INC. d/b/a ConAgra
Refrigerated Foods, a Delaware corporation,

Defendant.

Case No. CIV-01-347-C

**DEFENDANT'S SUPPLEMENTAL BRIEF IN RESPONSE TO
PLAINTIFFS' MOTION FOR PARTIAL SUMMARY JUDGMENT
REGARDING PATENT INVALIDITY AND UNENFORCEABILITY**

Pursuant to this Court's Order dated July ___, 2002, Defendant, Swift-Eckrich, Inc. respectfully submits the following Supplemental Brief in Response to Plaintiffs' Motion for Partial Summary Judgment Regarding Patent Invalidity and Unenforceability:

Plaintiffs attempt to demonstrate "invalidity" by relying on the testimony of multiple third party witnesses. As made clear by a recent Federal Circuit decision, such evidence does not meet the "clear and convincing" standard that applies to charges of patent invalidity.¹ The inadequacy of this type of shotgun evidence, even after a finding of invalidity by a jury, was addressed in Juicy Whip, Inc. v. Orange Bang, Inc., 292 F.3d 728 (Fed. Cir. 2002), decided on June 7, 2002. A copy of the opinion is attached hereto as Exhibit "A".

In Juicy Whip, Orange Bang sought to invalidate Juicy Whip's patent on a beverage dispenser by relying on evidence regarding two prior dispensers. To invalidate the patent, Orange Bang had to demonstrate that the prior dispensers (the alleged prior art) "met each of the limitations

¹ "Clear and convincing" is the evidentiary standard where the validity of a patent is in issue. Woodland Trust v. Flowertree Nursery, 148 F.3d 1368, 1369 (Fed. Cir. 1998).

of the claim" of the Juicy Whip patent. Id. at 737. Orange Bang did not present an element-by-element comparison between the patented product and the alleged prior art products. Id. at 738. Instead, six witnesses testified that they saw or used one or both of the allegedly prior art products more than one year before the application for the patent-in-suit was filed. Id. at 735. On this basis a jury found the patent to be invalid and judgment was entered on the verdict. That judgment was reversed by the Federal Circuit, as follows:

Even if the testimony at trial were sufficient to correlate each element of the alleged anticipatory dispensers with each claim limitation, this court must still ascertain whether that type of evidence was adequate to support the jury's finding. Historically, courts have looked with disfavor upon finding anticipation with only oral testimony. In *the Barbed Wire Patent*, 143 U.S. 275 (1892), the Supreme Court commented on the dangers of invalidating a patent on oral testimony alone.

In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information.²

Id. at 740.

2 In Barbed Wire, there were twenty-four witnesses.

The pertinent holdings of Juicy Whip are as follows:

1. **Oral** testimony of prior public use must be corroborated by other evidence, even when there are numerous witnesses, before the clear and convincing standard can be met and the patent found invalid (id. at 737-38);
2. **Oral** testimony of the type on which Plaintiffs rely is particularly inadequate when the witnesses have an interest in the patent being found invalid (id. at 741-42);
3. The evidence of invalidity must be correlated with the claims **element-by-element** and it must be proven by clear and convincing evidence that **each limitation** is met (id. at 737); and
4. It must be proven that all claim limitations were met by a **single public use**, not that some limitations are met by one public use and some may have been met by another (id. at 737-38).

Here, each of Plaintiffs' witnesses, if believed, would at best provide evidence that some limitations of some claims are met. Nowhere in Plaintiffs' briefs is there **clear and convincing** evidence that any one alleged public use meets all the limitations of any particular claim of the Swift-Eckrich patent, much less all the limitations of all the claims in that patent. In addition, just as in Juicy Whip, Plaintiffs' witnesses have an interest in the patent being found invalid as they are competitors of the patentee Swift-Eckrich.

Juicy Whip is important here for another reason. It highlights the need for a full claim construction, without which the requisite "element-by-element comparison" to the alleged public uses is impossible. Id. at 738. Claim construction is a matter of law for the Court and is required in every patent infringement case. Markman v. Westview Instruments, 52 F.3d 967 (Fed. Cir. 1995). A patent cannot be determined to be invalid without first having a full claim construction.

In any event, a court may not invalidate the claims of a patent without construing the disputed limitations of the claims and applying them to the allegedly invalidating acts. See Scaltech, 178 F.3d at 1383, 51 USPQ2d at 1058 (emphasizing that the invalidating act must be within the scope of the claim) [also cited in Juicy Whip, 292 F.3d at 737]. Otherwise, as in this case, the decision invalidating the patent becomes effectively unreviewable. Such evaluation must recognize the statutory presumption of validity and the need for facts supporting a conclusion of invalidity by clear and convincing evidence. Merely concluding that the Breese prototype appeared to have a “swaged end that is not butted” is not a claim construction at all, much less a full claim construction and application sufficient to overcome the presumption of validity of claims reciting “substantially uniform wall thickness” by clear and convincing evidence. In the absence of that claim **construction**, and the application of the **claims** to the alleged prior invalidating acts, **summary judgment** of invalidity was therefore wrongly granted.

Dana Corp. v. American Axel & Marketing, Inc., 279 F.3d 1372, 1376 (Fed. Cir. 2002) (emphasis in original).

In the present case, Plaintiffs have not presented the requisite “element-by-element comparison” between the alleged prior art and the asserted claims. The claims have not been construed nor has a claim construction hearing been requested or scheduled. Plaintiffs do not propose a full claim construction. Plaintiffs’ Reply Brief dismisses all claim construction issues in a single paragraph on page 11, with the exception of the term “golden brown” of which Plaintiffs offer no clear definition.

These deficiencies in Plaintiffs’ evidence and claim construction demonstrate that summary judgment on Plaintiffs’ invalidity claim is improper.

WHEREFORE, Defendant Swift-Eckrich respectfully requests the Court deny Plaintiffs’ summary judgment motion.

Dated: July ___, 2002.

Respectfully submitted,

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CERTIFICATE OF SERVICE

This is to certify that on this _____ day of July, 2002, a true and correct copy of the above and foregoing was filed and has been mailed, postage prepaid to:

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